

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-4, 6-13, 15-19, 22-28, and 30-45 are pending, wherein claims 1, 10, 16, 25, 36, 39, 42, and 45 have been amended.

Initially, Applicants note with appreciation the Examiner's withdraw of the previous grounds of rejection based on Applicants' previous communication. Further, Applicants note with appreciation the Examiner's consideration of the documents submitted with the Information Disclosure Statement (IDS) filed on October 25, 2004.

The Office Action rejects claims 36, 39, 42, and 45 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, these claims are rejected as containing subject matter "...wherein the progress indicator is a bar graph...", which is allegedly not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In order to address the Examiner's concerns, Applicants have amended these claims to read a "...wherein the progress indicator is a *graphical sliding bar*...", which Applicants believe is clearly illustrated as element 362 in Figure 3 of the present application. Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

The Office Action also rejects claims 1, 10, 16, and 25 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. In particular, the Office Action asserts that the term "may be" within the limitation of "...wherein the total amount of audio content that may be stored in temporary storage is limited to a predetermined maximum..." is indefinite. Although Applicants respectfully disagree that such term is necessarily indefinite, in the interest of expediting prosecution, Applicants' have amended these claims in order to address the Examiner's concerns. Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

The Office Action further rejects each of the pending independent claims (1, 10, 16, and 25) under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,760,696 to Goldberg et al. ("*Goldberg*") and under 35 U.S.C. § 103(a) as allegedly being unpatentable over

U.S. Patent No. 6,222,909 to Qua et al. ("*Qua*") in further view of U.S. Patent No. 6,453,281 to Walters et al. ("*Walters*"). The Office Action rejects the dependent claims as either allegedly anticipated under 35 U.S.C. § 102(e) by *Goldberg* or as allegedly being unpatentable under 35 U.S.C. § 103(a) over various combinations of *Goldberg*, *Qua*, *Walters*, in further view of U.S. Patent No. 6,351,523 to Detlef ("*Detlef*"), and/or U.S. Application Publication No. 2001/0045885 to Tett ("*Tett*").¹ For at least the forgoing reasons, Applicants respectfully traverse these grounds of rejection.

Applicants' invention, as claimed for example in independent method claim 1, relates to composing an electronic message using a mobile device. The method includes: receiving a command to begin composing an electronic message at a mobile device; receiving a command to add audio content to the electronic message at the mobile device, wherein a total amount of audio content added is limited to a predetermined maximum set for a single electronic message; diverting to a temporary storage within the wireless telephone, an audio content stream received at a wireless telephone voice input wherein the total amount of audio content diverted to temporary storage is limited to the predetermined maximum; displaying a progress indicator to show a current amount of temporary storage used in storing the audio content stream compared to the predetermined maximum; storing the audio content stream within the mobile device in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message at the mobile device. The other independent claims contain similar language for coverage of different aspects and embodiments.

Applicants respectfully submit that *Goldberg*, *Qua*, *Walters*, *Detlef*, and *Tett*, taken either individually or as a whole, do not render Applicants' claimed invention either anticipated or unpatentable for at least the reason that the cited references do not disclose or suggest each and every element of Applicants' claimed invention.² For example, the combination of *Goldberg*,

¹ Although the prior art status of the cited references are not being challenged at this time, Applicants reserve the right to do so in the future. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status or asserted teachings of the art of record.

² "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. That is, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."

In order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143 (emphasis added). In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

Qua, *Walters*, *Detlef*, and *Tett* does not disclose or suggest that a total amount of audio content added to an electronic message is limited to a predetermined maximum set for a single electronic message, as recited, *inter alia*, in independent claims 1, 10, 16, and 25.

Goldberg discloses a fast start voice recoding and playback on a digital device. Although *Goldberg* provides for a display block that states how many seconds remain available for recording sound files, *Goldberg* does not disclose or suggest that the amount of time available is set to a predetermined maximum for a single electronic message. In fact, col. 9, ll. 55-60 of *Goldberg* indicates that the remaining time is displayed as a function of the available memory on the hand held digital computer. Since *Goldberg's* time display is a function of available device memory and not a function of a predetermined maximum of audio content set for a single message, *Goldberg* actually "teaches away" from Applicants' independent claims.³

Next, the Office Action cites the combination of *Qua* and *Walters* as allegedly disclosing those elements within Applicants' independent claims. *Qua* discloses an audio note taking system and method for communication devices. Although *Qua* makes some mention of the limitations of memory for a detachable storage unit for storing recorded content, *Qua* does not disclose or suggest that such limitation is a predetermined maximum set for a single electronic message. In fact, col. 4, ll. 40-56, describe a recording overflow mechanism that prevents loss of information when the detachable storage unit 120 is full. Since *Qua* teaches a mechanism for allowing audio content to be recorded past some limited amount, and because *Qua's* limitation is a function of device capabilities and not a function of a predetermined maximum of audio content set for a single message—similar to *Goldberg*—*Qua* "teaches away" from Applicants' independent claims.

Recognizing some of the deficiencies of *Qua*, the Office Action cites *Walters*. *Walters* discloses a portable audio database device with icon-based graphical user-interface. Although *Walters* discloses a graphical display region with a status indicator that gives a visual representation of a relative percentage of memory utilization available or used, similar to *Goldberg* and *Qua*, *Walters* does not disclose or suggest that the percentage is based on a

or ordinary skill in the art, to modify the references or to combine reference teachings. MPEP § 2143. During examination, the pending claims are given their broadest reasonable interpretation, i.e., they are interpreted as broadly as their terms reasonably allow, consistent with the specification. MPEP §§ 2111 & 2111.01.

³ MPEP § 2141.02 states that the cited references must be considered as a whole, including those sections that "teach away" from the claimed invention. (Citation omitted).

predetermined maximum set for a single electronic message, as recited, *inter alia*, in independent claims 1, 10, 16, and 25. For at least the foregoing reasons, Applicants respectfully submit that the combination of *Goldberg*, *Qua*, and *Walters*—taken either individually or as a whole—does not render these independent claims anticipated or otherwise unpatentable.

With regard to the remaining reference cited by the Office Action, Applicants respectfully note the following. *Detlef* discloses the management of emails originated by thin client devices by providing an email-to-voicemail gateway. *Tett* discloses a system and method for retrieving and displaying paging messages. The Office Action relies on *Detlef* and *Tett* as allegedly disclosing various features and elements of the dependent claims. This cited art, however, does not overcome those deficiencies identified above with regard to the combination of *Goldberg*, *Qua*, and *Walters*. Accordingly, the combination of *Goldberg*, *Qua*, *Walters*, *Detlef*, and *Tett* does not render the independent claims anticipated or otherwise unpatentable.

Based on at least the foregoing reasons, Applicants respectfully submit that the cited prior art fails to anticipate or otherwise make obvious Applicants' invention as claimed for example, in independent claims 1, 10, 16, and 25. Applicants note for the record that the remarks above render the remaining rejections of record for the independent and dependent claims moot, and thus addressing individual rejections or assertions with respect to the teachings of the cited art is unnecessary at the present time, but may be undertaken in future if necessary or desirable, and Applicants reserve the right to do so.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and notice to this effect is earnestly solicited. Should any question arise in connection with this application, or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at +1.801.533.9800.

Dated this 29th day of November, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rick D. Nydegger", written over a horizontal line.

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